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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,779	02/25/2002	Scott C. DiNapoli	F-386	4414

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EXAMINER

BUTLER, MICHAEL E

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/082,779

Applicant(s)
DiNapoli et al.

Examiner
Michael E. Butler

Art Unit
3653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 25, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb 25, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U. S. C. 112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has conjoined elements using “or” with plural possible delineations as to what is being conjoined, particularly raising questions the delineations defining the breadth of the conjoined sub-elements. Appropriate correction is required. The claims have been otherwise examined on the merits presuming Boolean “OR.”

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Stengl which discloses:

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(Re: cl 1) An enclosure feeder system (500) for use with an inserter system that combines collations in a sequence of collations with a given number of respective corresponding specific enclosures, the enclosure feeder system for providing the enclosures to be combined with the collations, the enclosures for each successive collation ordinarily being separator by a divider indicator for indicating the end of the sequence of enclosures for a collation, the enclosure feeder system (500) comprising: enclosure feeding means (210), responsive to a feed count request for a collation and to an expected number of respective corresponding specific enclosures, for feeding the specific enclosures and for providing an enclosure count corresponding to the number of specific enclosures actually fed (c1 L 43-59);

and supervisory control means (300), responsive to the expected number of respective corresponding specific enclosures, for providing the feed count request for a collation and the expected number of respective corresponding specific enclosures, and further responsive to the enclosure count corresponding to the number of specific enclosures actually fed, for comparing the number of enclosures actually fed for a collation to the expected number of respective corresponding specific enclosures (300; c12 L 55-c13 L 4);

wherein the enclosure feeding means (210) continues feeding enclosures for the collation until either encountering a divider indicator or until the number of enclosures is equal to the expected number of enclosures (c 13 L 15-19);

(Re: cl 2) enclosure feeder system further comprising an input analyzer (501) for providing for each collation in the sequence of collations the expected number of respective corresponding specific enclosures; wherein the input analyzer (501) determines the expected number of respective corresponding specific enclosures based on information provided in a control document included in each collation (c 13 L 15-19);

(Re: cl 5) A method for monitoring and coordinating the processing of a sequence of collations through an inserter system, the inserter system for combining each collation in the sequence of collations with a given number of respective corresponding specific enclosures, the enclosures for each successive collation ordinarily being separator by a divider indicator for indicating the end of the sequence of enclosures for a collation, the method comprising: determining (401) for each collation in the sequence of collations the expected number of respective corresponding specific enclosures (c13 L 54-56);

searching (403) for each collation for an indication of the end of the sequence of enclosures for the collation c 13 L 60-c 14 L 14);

and feeding (403) the specific enclosures until either reaching the indication of the end of the sequence of enclosures for the collation or until having fed a number of enclosures equal to the expected number of enclosures (c14 L 1-10);

(Re: cl 6) the expected number of respective corresponding specific enclosures is determined based on information provided in a control document included in each collation (c14 L 24-34).

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stengl in view of Luperti et al. in which Stengl discloses the elements previously discussed and further discloses:

Lupertie et al. discloses the elements not inherently disclosed by Stengl of:

(Re: cl 3, 7) method and apparatus with enclosure feeder system further wherein if the enclosure feeding means discontinues feeding enclosures before encountering and recognizing a divider indicator, then the enclosure feeding means uses as the enclosure count for the collation a number based on the expected number of enclosures, and otherwise uses the number of enclosures actually fed for the collation (c 16L 26-30);

(Re: cl 4, 8) enclosure feeder system wherein the number based on the expected number of enclosures used as the enclosure count is one more than the expected number of enclosures (c16 L 15-23; c13 L 45-50).

It would have been obvious for Stengl to be modified to stop if a divider were encountered because if expected enclosures are omitted the divider alerts the feeder system to not feed the next document from the next intended enclosure as taught by Luperti et al. and come up with the instant invention as claimed. It would have been obvious for Stengl to specify an overcount number equal to one more than the expected number of enclosures to avert inserting extraneous or duplicated enclosures being fed as taught by Luperti et al. and come up with the instant invention as claimed.

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Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 and 5 and 6 are rejected under the judicially created doctrine of double patenting over claim 1-4 and 5-8 and 7-8 respectively of U. S. Patent No. 5,734,566 to Stengl. since the claims, if allowed, would improperly subject applicants to harassment from multiple assignees with the narrower patented claims disclosing the elements instantly claims.

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Conclusion

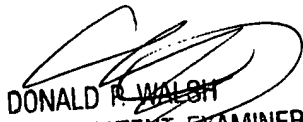
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exmr. Michael E. Butler whose telephone number is (703) 308-8344.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh, can be reached on (703) 306-4173. The fax number for the Group is (703) 305-7687.

Michael E. Butler

Michael E. Butler

Examiner


DONALD R. WALSH
SUPERVISORY PATENT EXAMINER
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